

Applicant : Miller
Patent No. : n/a
Issued : n/a
Serial No. : 09/629,262
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Attorney's Docket No.: 10001634-1

REMARKS

While the Applicant appreciates the Examiner's most recent review, the rejections made in light of the above claims are not supported by the facts in the cited references or case law as applied to these facts as the Examiner has suggested. Moreover, the obviousness rejections rely on only a single reference other than the Official Notice and Applicant's application. For reasons described below, Applicant respectfully submits that Official Notice and Applicant's application cannot be combined with the single reference in the manner suggested by the Examiner. Even so, it is not clear how this particular single reference alone or in combination renders the rejected claims obvious without applying hindsight in the process. At the very least, the Applicant would respectfully request the Examiner to reverse the final rejection as the case law and arguments do not support the Examiner's final rejection. More appropriately, however, Applicant would request that the claims presently on file in the above identified application be allowed as they are believed to be patentably distinguishable over the cited references.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Final Rejection Improper

According to MPEP 706.07, the Examiner is required to "repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof". In the present case, the Examiner rejected claims 1,2,4-7,9 and 10 by paraphrasing on pg. 3, lines 1-14 what appears to be the Examiner's interpretation of Lazarus with only a passing reference to Lazarus labeled "(see at least the summary and Fig. 1a, and 1b)". This does not clearly identify the claims rejected or the basis for each rejection. Further, the Examiner then quotes additional portions of Lazarus without specifying the claim or claims being addressed. Namely, the Examiner names the following references without specifying the corresponding claims: (col 3, lines 55-67 of Lazarus) and (col, 3, lines 10-54 of Lazarus). Applicant would respectfully request the Examiner reverse the final rejection and point out these arguments with particularity to facilitate a proper response or appeal as appropriate under the circumstances.

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Claim Rejections

In the office action mailed June 25, 2003, the Examiner rejected Claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 under 35 USC 103 in view of Lazarus, Applicant's disclosure and Official Notice. According to MPEP § 2143.03, an obviousness rejection requires that all claim limitations must be taught or suggested.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art."

In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970).

For reasons described below, the Applicant submits that the Examiner has not provided all the claim limitations with particularity and therefore failed to provide a prima facie case of obviousness as stated above.

First, Applicant would respectfully request the Examiner to provide a basis for taking Official Notice in this case as only one reference outside the Applicant's own disclosure is cited. In particular, the Examiner states it is both "old and well known in the art that information may be displayed in numerous manners" and then concludes that it would be "obviousto graphically display the predictive modeling of Lazarus using motion, color, size, shape length, direction, intensity" without citing a single supportive reference. At best, the Examiner appears to be creating facts based entirely on Applicant's disclosure using hindsight as the only reference. Since there is no basis in Lazarus for providing a graphical display of data, it is clear that Lazarus cannot stand for this proposition.

Even so, other aspects of the Examiner's rejection are not properly supported. The Examiner admits that Lazarus does not include recency, advocacy or monetary factors in their calculation but instead relies entirely on the background section of the Applicant's application. Unfortunately, the background mentions that these factors were previously used but could not

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yield appropriate results as the information could not be organized or visualized in an appropriate manner. As a result, many conventional marketing tests would fail for testing a wrong hypothesis. The Applicant made it clear that while these factors were known, they were of marginal use as they could not be graphically displayed or manipulated in a useful manner (pg. 2, lines 1-28 of the Application). Accordingly, the Applicant did not state that these factors could be used in Lazarus as the Examiner has assumed. And even if it were in Lazarus, there is no mention of graphically displaying information in Lazarus so combining these three factors with Lazarus would not yield graphically displaying this information as recited in Claim 1 and elsewhere.

With respect to Lazarus providing a "galaxy layout according to polar coordinate system", there is also no basis for this assertion. As the Examiner has noted, Lazarus only describes using clustering to place information into a vector (col. 3, lines 10-54). This reference makes no mention of displaying this information graphically on any display device let alone in a 3-dimensional galaxy representation as the Examiner has asserted. Once again, the Examiner is using hindsight and the Applicant's own disclosure to construct a reference. Because the Applicant cannot find a reference in Lazarus to graphically display in this manner, the Examiner's assertion cannot hold and render obvious Claim 1 in the instant case.

Even if Lazarus did disclose a "galaxy display" somewhere in the four corners of the patent, it would still not render the Applicant's invention obvious. The Examiner has argued that it would be obvious "to remove the clustering techniques to present the data in clusters, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art, In Re Karlson, 136, USPQ 184". Before analyzing the case law,¹ it is important to make two points. First, the Examiner improperly equated the "cluster calculations" in Lazarus used to process

¹ While it is true that in *In re Karlson*, 311 F.2d 581, 584, 136 USPQ 184, 186 (CCPA 1963) the Court stated that "omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before," this is not the case in the present set of facts. Further, the courts also recognize that this is not a mechanical rule, and that such language in *Karlson* was not intended to short circuit the determination of obviousness mandated by 35 U.S.C. § 103. See *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

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vectors of data (col. 3, lines 10-66 of Lazarus) with "techniques to present the data in clusters" (pg. 4, lines 2-6, Office Action) referring to Applicant's invention. These two terms, while similar in sound, have entirely different meanings and cannot be equated. On the one hand, Lazarus is using the "cluster" term to refer to a mathematical operation on a group of values while the Application is displaying information in a manner that creates "clusters" of visual information.

Second, the Examiner makes an erroneous conclusion that calculations associated with "clustering" as described in Lazarus can be removed and replaced with the visual display of clusters that arises in the Applicant's invention. There is nothing in Lazarus to indicate that one could "remove the clustering technique [in Lazarus] to present the data in clusters [as provided by the Applicant's invention]" (pg. 4, lines 2-6, Office Action); in fact, removing clustering in Lazarus is likely to render Lazarus completely inoperable since it is part of the algorithm used in Lazarus for data gathering.

In conclusion, Applicant submits that the Examiner's rejections must be withdrawn along with the Final Office action in light of at least the above arguments. The Examiner's rejection of Claims 1 under 35 USC 103 in view of Lazarus, Applicant's disclosure and Official Notice are not properly supported as there is insufficient support for the references and no direct connection between limitations in the Claims as filed and the references cited. Of course even if proper support for the references were made, these references do not teach or suggest aspects of the invention as presently claimed. In some cases, the teachings of the present invention would even render the cited reference Lazarus inoperable. Applicant has also submitted a Notice of Appeal to pursue this matter further in the event the Examiner does not withdraw the final rejection and/or allow the present claims.

Claim 11 provides a different embodiment or aspect of the present invention, and as amended, is also distinguishable over the cited references for at least the reasons provided above, and is therefore also in condition for immediate allowance. With respect to dependent Claims 2, 4-7, 9-10, 12, 14-17, 19, and 20 the cited references also fail to describe each and every element of these claims for at least the same reasons as described above in Claim 1 or Claim 11.

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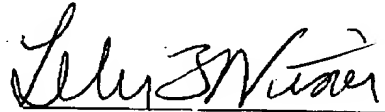
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Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Leland Wiesner, Applicants' Attorney at (650) 853-1113 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

September 24, 2003
Date


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